

### **REMARKS**

Upon entry of the present amendments, claims 1-2, 4, 6-9, and 11-19 constitute the pending claims in the present application. Claims 3, 5, and 10 were previously cancelled. Claims 1-2, 4, 6-9, and 11-19 stand rejected.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Office will be addressed below in the order they appear in the prior Office Action and using the enumeration from the prior Office Action.

#### **1. Elections/Restrictions**

Applicants note with appreciation that the restriction requirement issued February 13, 2007 has been withdrawn in view of Applicants' prior remarks.

#### **3.-8. Claim Rejections – 35 U.S.C. 112 – Claims 4, 7, 8, 13, 16**

Claims 4, 7, 8, 13 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

In particular, regarding claims 4, 13, and 16, the Office considers the phrase “may be” as indefinite. Applicants assert that this phrase is intended to describe that the recited structural element is adapted to perform the recited function. In order to clarify, Applicants have amended these claims to recite that the window (or cutting edge for claim 16) is “adapted to ...” Accordingly, Applicants request reconsideration and withdrawal of this rejection.

For claims 7-8, the Office has pointed out that there is not sufficient antecedent basis for “shielding mechanism.” Applicants have amended this phrase to recite “shield,” which has sufficient antecedent basis. The Office has also indicated that it is unclear how the proximal tabs of claim 7 can “undo the shield.” For the purposes of advancing prosecution, Applicants have amended claim 7 to incorporate the Office's suggested language. Accordingly, Applicants request reconsideration and withdrawal of this rejection.

Lastly, for claim 8, the Office has indicated that since “the implant’ has not been positively recited in claim 1, ... it is not clear whether this implant is part of the preamble recited in claim 1 or is a structural element that is part of the device.” Applicants disagree. As an initial point, Applicants, respectfully highlight that claim 8 is dependent from claim 7, which is an independent claim, so the recited features of claim 1 have no bearing on the determination of definiteness for claim 8. Applicants presume the Office was intending to refer to claim 7 and not claim 1. Claim 7 indeed recites “the implant” in the preamble, and claim 8 simply further defines the implant that is recited in the claim 7 preamble. Hence, Applicants submit that claim 8 is clear and definite as currently amended because it further defines the characteristics of the implant that may be used in association with the claimed device. Applicants accordingly request reconsideration and withdrawal of the rejection.

9.-13. Claims Rejections – 35 U.S.C. 102(b) – Claims 1-2, 4, 6, 11-19 over Benderev

Claims 1-2, 4, 6, and 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5,439,467 to Benderev et al. (“Benderev”). Applicants respectfully traverse the rejection.

The Office asserts that Benderev discloses the features of claim 1 and points to various elements of the Benderev instrument and compares these to the present claims. *See* paragraph 11 of the outstanding Office Action. In particular, the Office contends that Benderev discloses an instrument comprising “... c) a blunt tip 140 (col. 5, lines 12-17) disposed at a distal end of the shaft 125 (fig. 2) for blunt dissection of tissue...” *Id.* Applicants disagree and assert that a fair comparison of the blunt tip recited in claim 1 with the instrument of Benderev requires comparison not with the engaging face 140 of the Benderev probe guide 125, but rather with the distal end 120 of the Benderev probe 115 since it is the distal end 120 that is the distal most apical portion of the Benderev device, i.e., the tip. As indicated in Benderev, the distal end 120 of the probe 115 is sharpened (*see* column 5, lines 44-45); it is not a blunt tip as recited in claim 1.

Furthermore, even if one considers, as the Office is suggesting, only the probe guide 125 without the sharpened tip 120 of the probe 115 (e.g., FIGs. 2-4 of Benderev with the probe 115 and its sharpened tip 120 absent), then the probe guide 125 is hollow/open at its distal end because nothing would be filling the space vacated by the probe 115. In this scenario, the probe guide 125

would also not have a blunt tip, as recited in claim 1, because the hollow/open end would have a flat circular surface with a hole in the middle, and such a flat surface with a hole is structurally distinct from a blunt tip. Furthermore, such a flat circular surface with a hole would not be capable of “blunt dissection of tissue,” as recited in claim 1, since tissue would become clogged in the hole.

Finally, although the Office refers to column 5, lines 12-17 of Benderev to support the assertion that the tapered engaging face 140 of probe guide 125 is a blunt tip, FIGs. 2-4 of Benderev depict that the engaging face 140 is not a tip at all, but only the tapered circular side of the probe guide 125. Column 5, lines 12-17 of Benderev does not teach or suggest that engaging face 140 is a blunt tip either generally or “for blunt dissection of tissue,” as recited in claim 1, since this passage instead recites, “The distal extreme of tapered face 140 is slightly rounded or polished so that it can be pressed lightly against and swept along the surface of tissue ... without cutting or traumatizing the tissue” (emphasis added). Hence, the figures of Benderev teach that the engaging face 140 is not a blunt tip, and the specific Benderev passage relied on by the Office plainly teaches that the engaging face 140 is not for dissection of tissue, in contrast to the blunt tip recited in claim 1.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (see MPEP 2131 quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Since for the numerous reasons above Benderev does not teach all the features of claim 1, such as the recited blunt tip for blunt dissection of tissue, this reference cannot be used to maintain the outstanding novelty rejection of this claim or those dependent thereon. Accordingly, Applicants request reconsideration and withdrawal of the rejection.

14.-15. “Same Invention” Double Patenting – Claims 7-9

Claims 7-9 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 15-17 of the Preliminary Amendment dated March 8, 2006 of copending Application No. 10/973,191. Without addressing the merits of this rejection, Applicants note that since this is a “provisional” rejection, upon a finding of the present claims as otherwise allowable, this “provisional” rejection must be withdrawn pursuant to the pendency of the 10/973,191 application (MPEP 804).

16-17. Obviousness-Type Double Patenting – Claims 1-2, 4, 6, and 11-19

Claims 1-2, 4, 6, and 11-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 10-14 and 18-20 of copending Application No. 10/973,191 (the ‘191 application). Applicants respectfully traverse the rejection.

The Office contends that “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the claims have the same scope and elements.” Applicants disagree and respectfully direct the Office’s attention to claim 1 of the ‘191 application, which recites the feature of “a grasping mechanism located within a distal end portion of the shaft, the grasping mechanism including a movable element that includes a cutting edge.” Such a feature is not present in the claims of the present application. Moreover, instant claim 1 recites the feature of “a window including an L-shaped slot located within a distal end portion of the shaft, the L-shaped slot including a first leg extending radially inward and a second leg extending axially in a distal direction from an inner end of the first leg.” Such a feature is not recited in claim 1 of the ‘191 application. Hence, contrary to the Office’s position, the conflicting claims neither have the same scope nor have the same elements. For this reason, a *prima facie* case of obviousness-type double patenting has not been established, and Applicants request reconsideration and withdrawal of the rejection.

Finally, Applicants further note that since this is also a “provisional” rejection, upon a finding of the present claims as otherwise allowable, this “provisional” rejection must be withdrawn pursuant to the pendency of the 10/973,191 application (MPEP 804).

**CONCLUSION**

In view of the above arguments and amendments, Applicants believe the pending application is in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000.

Should an extension of time beyond that mentioned above be required, Applicants hereby petition for same and requests that the additional extension fee and any other fee required for timely

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consideration of this submission to Deposit Account No. 18-1945, under Order No. MIY-P01-011  
from which the undersigned is authorized to draw.

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Respectfully submitted,

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